

REMARKS

Claims 1, 4, 5, 7-13, 15, 16 and 18-20 are pending in the present application. Claims 8-13, 15, 18 and 19 are withdrawn. No new matter has been presented.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 4, 5, 7, 16 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **McCaffrey** (US 2001/0038450) in view of **Ryoji** (Engineering Materials, 1999).

Favorable reconsideration is requested.

(1) Applicants respectfully submit that the invention as recited in the claims is non-obvious over the prior art because the invention as recited in the claims provides unexpected results over the prior art.

The results in Table 4 demonstrate that even though grounding is set in the photometry chamber as taught in McCaffrey, the background value is not suppressed, but that when an anti-static sheet is used, the background value is suppressed.

Applicants have also prepared additional experimental data submitted in the attached Declaration under 37 C.F.R. § 1.132. McCaffrey teaches that the photo-detecting transducers used for detecting luminescence are very sensitive to static charge, and a sample chamber of known devices must be made of a conductive material or some other means must be provided to remove static charge from the sample chamber. Ryoji discloses Novalloy E which is a persistent static elimination ABS resin. The data compares the effect of the use of the anti-static tape of the present invention with the effect of the use of Novalloy E which is persistent static elimination

ABS resin disclosed in Ryoji (the alleged modified device of McCaffrey in view of Ryoji) to the suppression of the background value at the measurement of luminescence.

As is clear from Table A in the Declaration, the use of Novalloy E cannot suppress the background value. That is, even when Novalloy E is used in McCaffrey's sample chamber, the object of the present invention cannot be accomplished. In contrast, as is clear from Table A in the Declaration, the measurement using anti-static tape can suppress background value. Therefore, the present invention has the unexpected superior effect over the combination of McCaffrey and Ryoji.

The Office Action takes the position that the use of electrostatic elimination material is taught in Ryoji, and further that Ryoji teaches the superiority of using electrostatic elimination material rather than merely grounding an integrated circuit. (Office Action, pages 3-4.) The Examiner further alleges that Ryoji already demonstrates the superior effect from using an anti-static material because it is used in an integrated circuit manufacturing process and in air cleaners. (Office Action, page 4.) However, there is nothing in the prior art references to suggest that the use of electrostatic elimination material is superior to merely grounding the integrated circuit. Ryoji merely teaches an improved antistatic material. Ryoji does not teach or suggest the superiority of using an antistatic material over the use of grounding as alleged in the Office Action. And as demonstrated in the Examples and Comparative Examples of the present specification and the Declaration, even when Novalloy E is used in McCaffrey's sample chamber (the alleged modified device), the background value cannot be suppressed.

(2) Applicants respectfully submit that it would not have been obvious to combine the teachings of McCaffrey and Ryoji.

McCaffrey discloses that “many photodetecting transducers used for the detection of luminescence are very sensitive to static charge.” (McCaffrey, paragraph 15, lines 1-3.) It is known that resin easily charges with electricity. Novalloy E disclosed in Ryoji is made of ABS resin. (Ryoji, Title.) Therefore, one of ordinary skill in the art would not use Novalloy E which is made of resin as a material of the photometry chamber in McCaffrey.

In addition, as is mentioned in McCaffrey, “conventionally, a sample compartment of known devices must be made of a conductive material.” (McCaffrey, paragraph 15, lines 1-7.) In general, a photometry chamber is made of metal which is a conductive material, and metal is much more conductive than Novalloy E which is resin. Therefore, one of ordinary skill in the art would not select resin as a material of photometry chamber.

The Office Action takes the position that Novalloy E has the property of persistently eliminating electrostatic effect. (Office Action, page 5.) However, the fact that Novalloy E has the property of persistently eliminating electrostatic effect, does not mean that it does not easily charge with electricity or that it is as conductive as metal.

Applicants also note that the references must be viewed as a whole, and that when viewing the references as a whole, even though Novalloy E has the property of persistently eliminating electrostatic effect, it also has other properties such that one of ordinary skill in the art would not use the material in the chamber of McCaffrey as explained above and in the previous response.

In addition, the Office Action asserts on p.4, lines 17-18 of the Office Action that “Surface resistivity of $10^{11} \Omega$ order [Novalloy E] is clearly much higher than aluminum. Surface resistivity of $10^8 \Omega$ order is also much higher than aluminum.” However, one of ordinary skill in the art would have understood that if the surface resistivity of a material is high, the material would be electrically charged, easily. Therefore, one of ordinary skill in the art would not use such a material for the measurement which is very sensitive to static charge.

For at least the foregoing reasons, claims 1, 4, 5, 7, 16 and 20 are patentable over the cited references. Accordingly, withdrawal of the rejection of claims 1, 4, 5, 7, 16 and 20 is hereby solicited.

In view of the above remarks, Applicants submit that the claims are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants’ undersigned attorney to arrange for an interview to expedite the disposition of this case.

Application No. 10/561,538
Art Unit: 1797

Response under 37 C.F.R. §1.116
Attorney Docket No. 053362

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

/Andrew G. Melick/

Andrew G. Melick
Attorney for Applicants
Registration No. 56,868
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

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Attachment: Declaration under 37 C.F.R. § 1.132